

REMARKS

Careful examination of the application is sincerely appreciated.

In response to the objection to the drawings, two Replacement Sheets are enclosed herewith. The enclosed Replacement Sheets include the requisite changes and add no new matter. Entry of the revised drawings is respectfully requested.

The specification is objected to in view of the objections to the drawings. In view of the changes to the drawings as discussed above, withdrawal of the objection to the specification is requested.

According to the Office Action, claims 6, 7, 10, 17 and 18 were rejected under 35 USC 112, second paragraph. In response, to advance the prosecution of the application and without conceding any statements or waiving any arguments in the Office Action, Applicant's claims are amended to more clearly define the invention.

With reference to Applicant's claims 6 and 7 reciting the feature of "prompting the user for greater detail ...," the examiner's comments, including his emphasis on "greater detail," is not understood by Applicant's representative. It is not clear how "greater detail" or the entire Applicant's recitation can be construed as the alleged "intended use." Even if it were so, it is also not clear on what basis the examiner rejects the claim based on the doctrine of the so-called "intended use" as the examiner is required to treat every claim recitation as limitation. The examiner is requested to cite cases to support his proposition on the so-called "intended use." It is also not clear on what basis the examiner asserts that the "greater detail" is a required element. Applicant did not indicate anywhere in the specification that "greater detail" is a required

element of the claimed invention. If the examiner disagrees, he is respectfully requested to indicate those portions of the specification stating otherwise. In the absence of such explicit disclosure, the examiner is requested to provide case law to support his proposition of unilaterally deciding on whether the element is required or not.

It is believed that Applicant's claims now fully comply with 35 USC 112. Withdrawal of the rejection is respectfully requested.

According to the Office Action, claims 6 and 7 – 13 are rejected under 35 USC 101. In response, the rejections are respectfully traversed as failing to comply with proper examination in accordance with the established cases and statutory law.

Applicant's claimed invention is directed to a computer-implemented method of generating a diary record. The examiner is referred to the claim preamble and specification for support. Independent claims 6, 7 and 10 recite functional steps of a method, which clearly falls within an enumerated statutory category of section 101. In addition, a computer-implemented method of generating a diary record is a practical application.

If the examiner disagrees, he is respectfully requested to support the 101 rejection by stating that 1) a method is not statutory subject matter under 35 USC 101, and 2) a computer-implemented method of generating a diary record is not a practical application. It is respectfully submitted that the examiner's rejection is improper and must be withdrawn.

If the examiner maintains the rejection, he is requested to elaborate on how Applicant's claims "produce results that are transparent to users and/or to other components of the claims."

The examiner is also requested to provide support, citing case law, for his proposition of "transparent results" not being eligible for patent protection.

Further according to the Office Action, claims 1, 3, 4, 10 and 14-16 are rejected under 35 USC 103(a) as being obvious over US Patent 6,470,449 (hereinafter "Blandford") in view of US Published Application US20010027446 (hereinafter "Metcalf").

In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a *prima facie* case of obviousness in accordance with the established cases and statutory law.

It is respectfully submitted that the examiner failed to establish a *prima facie* case of obviousness. The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if any one of the above-identified criteria is not met, then the cited references fail to render obvious the claimed invention and the claimed invention is thus distinguishable over the cited references.

Blandford is directed to a computer diary that archives a diary entry by creating, time

stamping, authenticating and permanently storing a reference data block along with each diary entry. The manner that the entries are archived allows for a stringent method to modify and an easy method to authenticate. (See Blandford, abstract). Blandford may accept data from a computer via a communications port. (See Id., col. 15, l. 66 – col. 16, l. 1). If there is a match between an original entry and a discrepancy such as an unauthorized modification, then an archive function may be called. (See Blandford, col. 14, ll. 30-42). If there is a match between a checksum and a master flag (*e.g.*, master password), then a user may archive the entry. (See Blandford, col. 15, ll. 11-15).

Metcalfe is directed to an electronic system for regulating activity that includes a standard user interface that requires all information presented in the system to be formatted in a standard manner that is designed to achieve results. (See Metcalfe, abstract). The system uses several levels of interfaces, in particular the secondary interface that prompts users to input information in specific fields and formats. (See Metcalfe, p. 4, ¶ 35). The purpose of the interface is to gather enough information that is subjective to a user in order to achieve the ultimate goal of the system (*i.e.*, solve problems associated with currently trying to do business on the Internet). (See Metcalfe, p. 4, ¶ 36-39).

Among other things, it is submitted that the cited patents do not disclose adding a record to a database defining the historical record that includes data from the step of classifying and data from the step of accepting as recited in claim 1. The examiner contends that Blandford teaches “adding a record to a database defining the historical record including at least one data resulting from the step of classifying and data resulting from the step of accepting.” Applicants

respectfully submit that Blandford does not disclose this feature of Applicant's invention. The archiving method disclosed in Blandford, instead, matches a prior archiving with the present archiving. (See Blandford, col. 14, ll. 30-42). The archiving method also discloses a matching of a checksum, which is simply an error detector, and a master flag, which is simply a user password. (See Blandford, col. 15, ll. 11-15).

In contrast, the present application discloses and claims an archiving when the historical data includes data resulting from the classifying and the data resulting from the accepting. That is, Blandford archives either a matching with respect to some form of time or authentication, whereas the present invention matches data resulting from a different type of entry, namely from the steps of classifying and accepting which entail an objective/subjective input match. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, discloses or suggests "adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting," as recited in claim 1.

It is further submitted that the cited patents do not disclose an event being unrelated to a calendar/diary application as recited in claim 1.

The examiner has correctly stated that Blandford does not teach classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto, said event being unrelated to a calendar/diary application, and prompting a user, by a calendar/diary application, to enter data relating to the event for incorporation in a historical

record of events pertaining to a user. The examiner has attempted to cure this deficiency with Metcalfe.

Metcalfe discusses subjective input in their tiers of interfaces. Specifically, Metcalfe includes steps of prompting a user for and receiving from the user who/what information relating to the activity, why/how information relating to the activity, and where/when information relating to the activity. (See Metcalfe, p. 3, ¶ 25). All of these inputs require some subjective information that pertains, in particular, to the user. This is markedly different from the recited “said event being *unrelated* to a calendar/diary application,” because the standard with regards to the event is objective. That is, in the classifying step, the event is unrelated and independent of the user until, after the prompting, there is a match between the data that results from the classifying and the data that results from the prompting. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, disclose or suggest classifying and generating an indicator of an event, “said event being unrelated to a calendar/diary application,” and “adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting,” as recited in claim 1.

In addition to Blandford and Metcalfe not teaching the above-recited limitations, Appellants also maintain that it would not have been obvious to a person having ordinary skill in the art to modify Blandford by the teaching of Metcalfe. As discussed above, Blandford pertains to a computer diary that has several levels of security, even to the user. Metcalfe, on the other hand, pertains to an entirely different archiving of information, namely gathering of information

to conduct a business on the Internet (*e.g.*, keeping business records). The mere similarity that both inventions deal with computers and archiving should not preclude the present application since such a combination would not have been obvious to one skilled in the art.

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. In re Oetiker, 977 F. 2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F. 2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggest the claimed subject matter. In re Fine, 837 F. 2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, “[t]he factual inquiry whether to combine references must be through and searching.” In re Lee, 277 F. 3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), citing McGinley v. Franklin Sports, Inc., 262 F. 3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “It must be based on objective evidence of record.” Id. “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” In re Dembiczak, 175 F. 3d 994, 999, 50 USPQ2d 1614, 1617. “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” Dembiczak, 175 F. 3d at 1000, 50 USPQ2d at 1617, citing McElmurry v. Ark. Power & Light Co., 995 F. 2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion on the Office Action that the combinations of prior art references “would be obvious to one having ordinary skill in the art...” is respectfully refuted. One may not utilize the teaching of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references

including the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. (See, In re Rouffet, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, In re Rouffet, 1458).

The U.S. Court of Appeals for the Federal Circuit (the “Federal Circuit”) restated the legal test applicable to rejections under 35 U.S.C. §103 (a) in the In re Rouffet holding. The Court stated:

[V]irtually all [inventors] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting parents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention. This court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board (of Appeals) did not, however, explain what specific understanding of technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 USC 103(a). In this case, the Court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in details the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, not does the Board make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper analysis.

In re Dembiczak, 50USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both In re Rouffet and In re Dembiczak it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Blandford with the other prior art, could only have been made with impermissible hindsight based on the teaching of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art, nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature.

Al-Site Corp. v. VSI International Inc., 174 F. 3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)

(Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicant again respectfully submits that the examiner has used impermissible hindsight to reject claims 1, 3-6, 10, and 14-18 under 35 USC 103(a). As discussed above, the Federal Circuit in In re Rouffet stated that virtually all inventions are combinations of old element. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the examiner is required to show a motivation to combine the references that create the case of obviousness. Applicant respectfully submits that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984), and In re Laskowski, 871 F. 2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that “to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability.” (Sensonics, Inc. v. Aerosonic Corp., 81F.3d 1566, 38 USPQ2d 1551

(Fed. Cir. 1996). “ To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against each teacher.” (*In re Zurko*, 111 F. 3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). A critical step is analyzing the patentability of claims pursuant to section 103 (a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘ to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited reference omitted).” (*In re Kotzab*, 208 F. 3d 1352, 54 USPQ2d 1308 (Fed. Cir. 1997).

Applicant respectfully maintains that there is no suggestion in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the Appellants’ claimed invention.

Considering MPEP 2143, it is stated:

“THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” And, “FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device “ may be capable

of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d at 682, 16 USPQ2d at 1432.).”

There is no such suggestion in either Blandford or Metcalfe that would justify such a combination.

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner’s lack of specificity with regard to the motivation to combine the cited references, none of the suggested combinations of prior art utilized to reject each of claims 1-4, 10, and 14-16 finds proper motivation for combination.

Since at least one of the above-identified criteria of the test for determining if a claim is rendered obvious is not met, the cited references, separately or in combination, fail to render obvious the claimed invention. The claimed invention, according to claim 1, is thus distinguishable over the cited references.

At least for the above reasons, Applicant submits that the rejection of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

Analysis of independent claims 10 and 14 is analogous to the one of claim 1, as presented hereinabove. To avoid repetition, claims 10 and 14 will not be discussed in detail with the understanding that they are patentable at least for the same reasons as claim 1. Applicant, therefore, respectfully requests withdrawal of the rejection and allowance of claims 10 and 14.

Claims 3, 4, 15 and 16 depend from independent claims, which have been shown to be allowable over the prior art references. Accordingly, claims 3, 4, 15 and 16 are also allowable

by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 3, 4, 15 and 16 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

The rejection of claim 5 under 35 USC 103(a) as being obvious over Blandford in view of Metcalfe and further in view US Published Application US2002/0005865 (hereinafter "Hayes-Roth") is traversed.

In the Office Action, the examiner rejected claim 5 under 35 USC 103(a) as being unpatentable over Blandford in view of Metcalfe further in view of Hayes-Roth. Blandford and Metcalfe are discussed above.

Hayes-Roth is directed to a method of interpreting user inputs to generate a set of responses through automated means. (See Hayes-Roth, abstract). Hayes-Roth provides a means of anticipating an abstract structure of prospective interactions between agents and their users, defining localized contexts within that abstract structure, and allowing authors to create content for each such localized context. (See Hayes-Roth, p. 1, ¶ 8).

Among other things, the cited patents do not disclose adding a record to a database defining the historical record that includes data from the step of classifying and data from the step of accepting, as recited in claim 1. Claim 5 depends from independent claim 1. Therefore, dependent claim 5 includes all of the elements and limitations of its respective independent claim. Hayes-Roth does not cure the above-described deficiencies of Blandford and Metcalfe. Thus, it is respectfully submitted that Blandford, Metcalfe and Hayes-Roth, either alone or in combination, fail to disclose or suggest classifying and generating an indicator of an event, "said

event being unrelated to a calendar/diary application,” and “adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting,” as recited in claim 1.

Furthermore, the cited patents describe no motivation to combine such technologies and would not have been obvious to one skilled in the art. The state of the law as set forth by the Federal Circuit is discussed above. It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the examiner’s lack of specificity with regard to the motivation to combine the cited references, none of the suggested combinations of prior art utilized to reject claim 5 finds proper motivation for combination.

The rejection of claim 6 under 35 USC 103(a) as being obvious over Blandford in view of Metcalfe further in view of US Published Application 20010049617 (hereinafter “Berenson”) is traversed.

In the Office Action, the examiner rejected claim 6 under 35 USC 103(a) as being unpatentable over Blandford in view of Metcalfe further in view of Berenson. Blandford and Metcalfe are discussed above.

Berenson is directed to an event scheduling system that allows users to request reminders of upcoming events over the Internet either by specifying the event to be reminded of or being reminded of events that meet a certain criteria. (See Berenson, abstract). The purpose of the system is to draw from various sources to remind a user of events defined by the user’s interests. (See Berenson, p. 1, ¶ 17).

The cited patents describe no motivation to combine such technologies and would not have been obvious to one skilled in the art.

Appellants maintain the prior argument that it would not have been obvious to a person having ordinary skill in the art to modify Blandford by the teaching of Metcalfe further by the teaching of Berenson. As discussed above, Blandford pertains to a computer diary that has several levels of security, even to the user. Metcalfe, on the other hand, pertains to an entirely different archiving of information, namely gathering of information to conduct a business on the Internet (*e.g.*, keeping business records). In addition, because Metcalfe pertains to conducting a business, criteria other than time of occurrence is naturally acceptable. On the other hand, because Blandford pertains to a computer diary where entries are earmarked specifically with time, it would not have been obvious to one skilled in the art to prompt a user for greater detail in an event defined by a record other than a time of occurrence, as recited in claim 6. The mere similarity that both inventions deal with computers and archiving should not preclude the present application since such a combination would not have been obvious to one skilled in the art.

The state of the law as set forth by the Federal Circuit is discussed above. It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the examiner's lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject claim 6 finds proper motivation for combination.

The rejection of claims 17 and 18 under 35 USC 103(a) as being obvious over Blandford in view of Hayes-Roth is traversed.

In the Office Action, the examiner rejected claims 17 and 18 under 35 USC 103(a) as being unpatentable over Blandford in view of Hayes-Roth. Blandford and Hayes-Roth are discussed above.

The cited patents describe no motivation to combine such technologies and would not have been obvious to one skilled in the art.

Applicant maintains the prior argument that it would not have been obvious to a person having ordinary skill in the art to modify Blandford by the teaching of Hayes-Roth. As discussed above, Blandford pertains to a computer diary that has several levels of security, even to the user. Hayes-Roth, on the other hand, pertains to an entirely different computer technology that deals with emotion generating responses. It is respectfully submitted that merely sensing a mood of a user as claimed in Hayes-Roth is insufficient to satisfy the deficiencies of Blandford, specifically “sensing and classifying states, events or moods of a user or said user’s environment; generating an index responsive to said step of sensing; adding said index and said user input to said diary database,” as recited in claim 17. The mere coincidence that the combination of both inventions making the claims obvious should not preclude the present application since such a combination would not have been obvious to one skilled in the art.

The state of the law as set forth by the Federal Circuit is discussed above. It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the examiner’s lack of specificity with regard to the motivation to combine the cited references, none of the suggested combinations of prior art utilized to reject each of claims 17 and 18 finds proper motivation for combination.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

February 1, 2007

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